

REMARKS

The Office Action dated May 18, 2007, has been received and carefully noted. The following remarks, and the enclosed verified translation, are submitted as a full and complete response thereto.

Claims 1, 3, 17, 19-22, 24, and 26-30 are currently pending in the application, of which claim 1 is an independent claim. Claims 1, 3, 17, 19-22, 24, and 26-30 are respectfully submitted for consideration.

Claims 1, 3, 17, 19-22, 24, and 26-30 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action took the position that the claimed subject matter was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor had possession of the invention. Specifically, the Office Action stated that there was not "adequate support in the disclosure, as originally filed, for the description of the movable electrode as being arranged as a 'torsion beam,' as now recited in claim 1, line 6." Applicant respectfully traverses this rejection.

Applicant is somewhat puzzled by the fact that the Office Action has rejected the claims based on the terminology "torsion beam," since it was the Examiner who suggested such terminology. Furthermore, as the Examiner himself had admitted by telephone, Figures 1, 2, 3, 4, 6, 7, 8, 9, 10, and 11, as originally filed, each fully support the recitation of the of the movable electrode being arranged as a torsion beam.

The term “torsion beam” is not found in the text of the specification. Nevertheless, Applicant is not in any way limited to the words found in the specification. Section 112 of the Patent Act states that the “specification shall contain a written description of the invention.” 35 U.S.C. §112. The Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The Federal Circuit has explained, however, that “[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.” *Id.* See additionally, *Kao Corp. v. Unilever United States, Inc.*, 78 USPQ2d 1257, 1260 (Fed. Circ. March 21, 2006). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement.

The concept claimed is fully supported in the specification, and especially in the figures, in such a way that one of ordinary skill in the art could clearly conclude that the inventor (*i.e.* Applicant) possessed the invention that is presently claimed. Therefore, the claims fully comply with the written description requirement. It is consequently, respectfully requested that the written description rejection be withdrawn.

Claims 1, 3, 17, 19-22, 24, and 26-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,862,795 of Mahon (“Mahon I”) or U.S. Patent No. 6,829,937 also of Mahon (“Mahon II”) in view of U.S. Patent No. 5,723,790 of

Andersson (“Andresson”). Applicant respectfully traverses this rejection as clearly improper, because neither Mahon I nor Mahon II can be cited as prior art to show obviousness of the claims of the present application.

Mahon I and Mahon II cannot be used to show obviousness of the claims of the present application, because 35 U.S.C. 103(c) specifically prohibits the U.S.P.T.O. from putting the references to such use. 35 U.S.C. 103(c) specifically indicates that if a reference is only available as prior art under subsection (e) of 35 U.S.C. 102, and if the reference was subject to an obligation of assignment to the same entity as the application under examination, then the reference cannot be used to establish obviousness of the claims of the application under examination. Mahon I and II meet both those qualifications, and consequently the Office Action’s usage of the references is clearly contrary to U.S. law.

Mahon I and II were each issued after the filing date of the present application. The present application was filed February 10, 2004, but Mahon I issued March 8, 2005, and Mahon II issued December 14, 2004. Accordingly, the only subsection of 35 U.S.C. 102, under which either Mahon I or Mahon II could possibly qualify as prior art is under subsection (e). Thus, both Mahon I and II meet the first aspect in qualifying as a prohibited reference under 35 U.S.C. 103(c).

Likewise, both Mahon I and II were under an obligation of assignment to the same entity as the present application. Mahon I’s assignee is listed on the cover of the patent as “VTY Holding Oy,” but this identification contains a typographic error, which is

shown on the certificate of correction, which corrects the error, such that the listed assignee is “VTI Holding Oy.” Similarly, Mahon II lists “VTI Holding Oy” as its assignee. It should be clear that Mahon I and II were both the invention of Mr. Geoffrey L. Mahon, and, thus, the clear assignment of Mahon II provides evidence that the typographically incorrect assignment of Mahon I was due to an unintentional error.

The present application was under an obligation of assignment to the same entity as Mahon I and II. Evidence of this mutual obligation of assignment is seen, for example, on the cover of the priority document, which lists “VTI Technologies Oy” as the applicant, by the original assignment filed together with the response to notice to file missing parts in the present application on July 6, 2004, which lists “VTI Technologies Oy” as the assignee (which was recorded the same day at Reel 015546, Frame 0567), by the fact that both Mahon I and Mahon II were assigned to VTI Holding Oy in 2002, and the fact that (although the precise address differs slightly between Mahon I and II and that of the present application) the same country, city, and even street is in common. Furthermore, additional evidence was provided in a previous response mailed August 25, 2006, which is already of record in the file wrapper of the present application. Thus, it is clear that Mahon I and II also each meet the second requirement for prohibited usage under 35 U.S.C. 103(c).

Accordingly, as has been shown above, neither Mahon I nor Mahon II may be legally used to show obviousness of the claims of the present application.

The Office Action, in the response to arguments section, asserted that Mahon I “additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).” This is simply not true. The Office Action pointed out that the foreign priority documents cannot be relied upon to show priority over Mahon I, because a certified translation has not been provided. However, there is no need to rely on the earlier filing date to which the present application is entitled, because the U.S. filing date is prior to the issue date of Mahon I. Consequently, Mahon I does not qualify under any other subsection of 35 U.S.C. 102, contrary to the Office Action’s assertion.

The Office Action also asserted that no evidence of mutual assignment of Mahon II has been provided. Regardless of whether such evidence had previously been provided, the explanation provided above should suffice to meet any reasonable burden of evidence, and that both Mahon I and Mahon II are clearly prohibited from being cited as prior art against the claims of the present application for the purpose of showing obviousness. Accordingly, it is respectfully requested that the obviousness rejection be withdrawn.

Furthermore, for the sake of completeness, a verified translation (into the English language) of the priority document for the present application is enclosed. Thus, if it were necessary (which it is not in this case), Applicant could properly rely on the priority of the earlier foreign filing for which priority has already been properly asserted, a certified copy of the priority document having been filed on July 6, 2004.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosures: Verified English Translation of Priority Document

CERTIFICATION

I hereby certify that the attached text "Capacitive Acceleration Sensor" is a true translation of the original Finnish Patent Application No. 20030207, filed on 11 February 2003.

Helsinki, 20 June 2007



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